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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,642	01/26/2001	Heinrich Gers-Barlag	BEIERSDORF-K	2689

7590 03/27/2002  
Norris McLaughlin & Marcus  
660 White Plains Road  
Tarrytown, NY 10591-5144

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
1617	

1617

DATE MAILED: 03/27/2002

11-21-02

Please find below and/or attached an Office communication concerning this application or proceeding.

Restarted response period 11/21/02  
due to change of address filed  
4/3/02 was never processed  
11/21/02  
B. Gray



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**Office Action Summary**

Applicati n No.

09/744,642

Applicant(s)

GERS-BARLAG ET AL.

Examin r

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Receipt is acknowledged of Amendment filed on January 9, 2002. Claims 1-11 are pending. Part of the rejections under 35 U.S.C. § 112 is withdrawn in view of applicants' amendment. Claim rejections under 35 U.S.C. § 103 over Gers-Berlag et al. (U.S. Pat. No. 5,725,844) in view of Intrioni (Cosmet. Toiletries, 1997, Vol. 18, No. 2) is maintained. A new rejection is established in view of the claim amendment by applicants.

#### *Claim Rejections - 35 USC § 112*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "finely dispersed" in claim 1 is a relative term which renders the claims vague and indefinite. Applicants assert in Remarks filed on January 9, 2002, that the term is known in the art as "hydrodispersions". Examiner notes that the specification defines the term hydrodispersions as "dispersions of a liquid, semi-solid or solid internal (discontinuous) lipid phase in an outer aqueous (continuous) phase." See p. 4, lines 19 – 23. The term hydrodispersions are viewed as more specific types of dispersions than the "finely dispersed oil-in-water or water-in-oil systems" recited in the instant claims.

In response to applicants' remark that examiners may not reject claims or insist on their own preferences, examiner asserts that the rejection herein is proper under § 112, second paragraph, for above reason. See MPEP 2173.05 (b).

The remaining claims are rejected as depending on indefinite base claim.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(A) Claims 1- 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. (U.S. Pat. No. 5,725,844) in view of Introini (Cosmet. Toiletries, 1997, Vol. 18, No. 3) ("Introini III" hereunder) and Oshima et al. (WO97/45097) (English equivalent US 6197282 B1).

Gers-Barlag et al. disclose photoprotective O/W emulsions or hydrodispersions, comprising hydrophobic inorganic pigments, UV filters and other cosmetic ingredients. See abstract; col. 1, line 44 – col. 8, line 49. The compositions are essentially emulsifier-free. The reference teaches that, while emulsifier-free compositions may be safer, addition of high quantity of UV filter renders tacky feeling. See col. 2, line 63 – col. 3, line 37. The reference fails to teach adding the boron nitride as required by the instant application.

Introini III teaches the use of boron nitride in cosmetic art. The cosmetically beneficial properties of boron nitride, including silky and rich feel, improved spreadability, improved color and adhesion, improved durability and evaporation, are disclosed. See p. 26, col. 1. In the same column the reference also discloses that the boron nitride used in the study is supplied from Advanced Ceramics, which also is a supplier of the boron nitride that may be used in the invention, as applicants disclose in spec. 6, lines 30-34. Introini lacks the teaching of the particle size or amphiphilic characteristic of boron nitride as claimed in the instant application. Although it is not

clear from the claimed language whether the boron nitride in claim 1 is treated or untreated, as mentioned in § 112 rejection above, examiner takes the view that the boron nitride used in Introini article may be the same type of boron nitride in the instant invention, meeting the limitations in the instant claims 5 and 9.

Gers-Barlag and Intrioni III fail to teach micronized organic pigments that are amphiphilic.

Oshima et al. teach sunscreen particles coated with silicone dispersants, having average particles size of 0.01 – 5.0 microns. See English equivalent, US 6197282 B1, col. 7, line 35 –col. 8, line 49. Examiner views that these fine particles coated with silicones meet the amphiphilic limitations of instant claim 10. The metal oxides of instant claim 11 are disclosed therein. Cosmetic formulations such as emulsions which comprise the coated inorganic particles are disclosed in Examples 15 – 22. The reference teaches that the sunscreen compositions according to the invention show good UV protection and no whitening of skin after the application. See Examples 15-22. The coated inorganic particles are also said to form stable dispersion in the cosmetic medium, to be easy to handle, and provide good texture on skin. See col. 5, lines 38 – 53. See also col. 17, line 46 – col. 18, line 34 for disclosure of the cosmetic application of the invention with conventional cosmetic ingredients including as boron nitride.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Gers-Berlag et al. by adding boron nitride as suggested by Introini III because of the expectation to have successfully eliminated the problem associated with stickiness of the emulsion composition and produced a composition with good lubricating properties, velvety and smooth feel. One

skilled in the art would have also expected that composition would evaporate rapidly, absorb oil and dissipate heat, which would be desirable for a sun care cosmetic composition. The substitution of the inorganic pigments in Gers-Barlag et al. with the silicone-coated micronized inorganic pigments as suggested by Oshima would have been also obvious to the skilled worker because of the expectation that the modified composition would form stable dispersion in the medium, provide good texture on skin and UV protection without leaving undesirable whitening effect.

(C) Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. (U.S. Pat. No. 5,725,844) in view of Intrioni (Cosmet. Toiletries, 1997, Vol. 18, No. 2) ("Intrioni II").

Rejection is maintained for reasons of record as indicated in the previous office action dated July 23, 2001.

### ***Response to Arguments***

Applicant's arguments filed on January 9, 2002 in response to the office action dated July 23, 2001, have been fully considered but they are not persuasive.

Applicants argue that Gers-Barlag et al. and Intrioni III teach away from each other because one having ordinary skill in the art would not add a component having a hydrophilic property to the water-repellant composition in Gers-Barlag et al. Examiner finds this argument unpersuasive. Gers-Barlag et al., while teaching a water-resistant cosmetic composition, also teaches to use water-soluble UV filter substances. See abstract.

Further, applicants argue that examiner's presumption of that the boron nitride in Intrioni III is based on inherency argument which is improper in § 103 rejections.

Examiner respectfully disagrees. See MPEP 2112 which states that the express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. § 102 or 103. Examiner also notes that the inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness. See In re Napier, 55 F. 3d 610, 613, 34 U.S.P.Q. 2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). The court in In re Spada also held that “products of identical chemical composition can not have mutually exclusive properties.” See 911 F.2d 705, 709, 15 U.S.P.Q. 2d 1655, 1658 (Fed. Cir. 1990); MPEP 2112.01. In this case, examiner had indicated in the previous office action that the amphiphilic characteristic of boron nitride is presumed based on the fact that the boron nitride of both Intrioni III and present invention are manufactured by same source.

Once the Office requires an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his or her claimed product. Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102 or prima facie obvious under § 103, applicants bear the same burden of proof. See MPEP 2112. “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” See In re Spade, at 709, 1658. In this case, examiner takes the position that the burden to show that an unobviousness difference between the prior art and present invention is on applicants. Absent evidentiary support for unobvious differences between the boron nitride in the prior art and the present inventions, the arguments presented in the Remarks filed on January 9, 2002, do not satisfy the burden of proof.



Regarding applicants' remarks on the rejection over Gers-Berlag et al. in view of Intrioni II, the argument is considered moot in view of the above reason.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

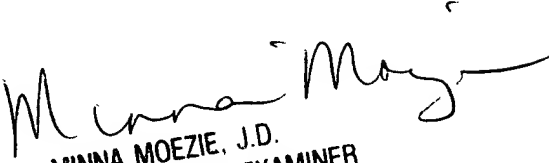
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
March 22, 2002

  
MINNA MOEZIE, J.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600